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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,119	02/05/2004	Guido Desie	27500-197	3253

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EXAMINER

NATALINI, JEFF WILLIAM

ART UNIT PAPER NUMBER

2858

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/773,119

Applicant(s)

DESIE ET AL.

Examiner

Jeff Natalini

Art Unit

2858

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-32 are pending in the current application with remarks submitted May 11, 2006. Claims 1-28 having been previously presented and claims 29-32 are new. The drawings submitted May 11, 2006 are accepted by the examiner.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3-9, 16, 17, 19, 21, and 23-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Seaver et al. (US Pub 2002/0192360).

In regard to claim 1, Seaver et al. discloses an apparatus for evaluating the triboelectrical properties (pg 13 paragraph 115) of at least two samples (figure 20 shows the properties of webs), comprising: a grounded means (pg 11 para 105 line 4-6; fig 3a (14))) for holding a material in sheet form (pg 11 para 105 lines 1-4) comprising a support provided (the grounded drum, fig 3a (14)) on at least one surface thereof with at least two samples each in at least one predefined region thereof (multiple samples- paragraph 106 table I, shows that different speeds are used to create multiple thicknesses of the web samples- the limitation "predefined region" is considered the whole drum as "region" does not provide any specific placement of the samples); a charging means for tribocharging said at least two samples (paragraph 115 states the

rollers pass a triboelectric charge to the samples-fig 3a (26)); and a means (7) for measuring an electrical property of said at least two samples (pg 12 para 107 line 1-4, properties shown in figure 20).

In regard to claim 3, Seaver et al. discusses wherein said grounded means for holding said support is a rotatable drum (pg 11 para 105 line 4-6; fig 3a (14)).

In regard to claims 4, 5, 16, and 17, Sever et al. discloses wherein a computer is able to perform a calculation on said measured electrical property (pg 9 para 90 lines 10-25).

In regard to claim 6, 19, 20, and 21, Seaver et al. discloses a grounded rotatable drum for holding the support in sheet form (pg 11 para 105 line 4-6; fig 3a (14)); a charging roller to tribocharge the sample (paragraph 115 states the rollers pass a triboelectric charge to the samples-fig 3a (26)); a measuring probe connected to a voltmeter for measuring electrostatic potentials (pg 12 para 107 line 1-5); a computer for handling outgoing and incoming data (pg 9 para 90 lines 10-25).

In regard to claim 7, Seaver et al. discloses wherein a software of a computer controls the rotation speed of said rotatable drum and the linear translation speed of said measuring means for measuring said electrical property across said support in sheet form (pg 9 para 90, and pg 11 para 106).

In regard to claims 8, 9, and 23-27, Seaver et al. discloses a means for post-treatment of the samples, wherein the means is a UV-curing means (pg 12 para 110 line 1-11).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 13-15, 18, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seaver et al. (US Pub 2002/0192360) in view of Huizinga et al. (4328280).

In regard to claim 2, Seaver et al. discloses all that is disclosed above in claim 1.

Seaver et al. lacks wherein one sample is a test sample and the other is a reference sample.

Huizinga et al. teaches wherein two samples triboelectric charge is evaluated and wherein one sample is a test sample and the other is a reference sample (col 7 line 62 – col 8 line 3).

It would have been obvious to one with ordinary skill in the art at the time the invention was made for Seaver et al. to have one sample as a test sample and the other as a reference sample as taught by Huizinga et al. in order to determine the effect of multiple surface treatments of samples (col 8 line 30-40).

In regard to claim 13, Seaver et al. discloses a grounded rotatable drum for holding the support in sheet form (pg 11 para 105 line 4-6; fig 3a (14))

In regard to claims 14 and 15, Sever et al. discloses wherein a computer is able to perform a calculation on said measured electrical property (pg 9 para 90 lines 10-25).

In regard to claim 18, Seaver et al. discloses a grounded rotatable drum for holding the support in sheet form (pg 11 para 105 line 4-6; fig 3a (14)); a charging roller to tribocharge the sample (paragraph 115 states the rollers pass a triboelectric charge to the samples-fig 3a (26)); a measuring probe connected to a voltmeter for measuring electrostatic potentials (pg 12 para 107 line 1-5); a computer for handling outgoing and incoming data (pg 9 para 90 lines 10-25).

In regard to claim 22, Seaver et al. discloses a means for post-treatment of the samples, wherein the means is a UV-curing means (pg 12 para 110 line 1-11).

6. Claims 10-12 and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seaver et al. (US Pub 2002/0192360) in view of Vanmaele et al. (EP 1243409).

In regard to claim 10 and 29, Seaver et al. discloses all that is disclosed in claim 1, and discloses wherein the tribocharging the samples such that a plateau value of charge is reached for each sample (figure 20, a high value of charge (plateau) is reached for each sample, and then the charge decreases from that value).

Seaver et al. lacks wherein an array of samples are evaluated and therefore lacks measuring sequentially the charge of the array of samples.

Vanmaele et al. teaches variants of multi-layered materials including film (pg 2 line 43-49) that are screened for useful electric properties by presenting an array of various coated materials (pg 2 line 57 – pg 3 line 6).

It would have been obvious to one with ordinary skill in the art at the time the invention was made for Seaver et al. to use an array of samples while evaluating properties of the material as taught by Vanmaele et al. in order to scan for useful properties in several variants of multilayered materials (pg 2 line 57-58), also with the addition of the array of samples, because Seaver et al. discloses a single voltmeter with a probe only one sample can be measured at a time (done sequentially).

In regard to claims 11 and 30, Seaver et al. discloses where the apparatus has a means for post-treatment, wherein the post-treatment comprises UV-curing step (pg 12 para 110 line 1-11).

In regard to claims 12, 28, 31, and 32, Seaver et al. contains wherein statistical calculations are performed on the samples (fig 20).

Seaver et al. lacks wherein the samples are in an array so that each different sample is present in at least two rows and two columns.

Vanmaele et al. teaches variants of multi-layered materials including film (pg 2 line 43-49) that are disposed in an array (pg 2 line 57 – pg 3 line 6; figs 2 and 3).

It would have been obvious to one with ordinary skill in the art at the time the invention was made for Seaver et al. to have different test samples present in at least two columns and two rows as taught by Vanmaele et al. in order to scan for useful properties in several variants of multilayered materials (pg 2 line 57-58).

Response to Arguments

7. Applicant's arguments filed May 11, 2006 have been fully considered but they are not persuasive.

In response to the rejection under 35 U.S.C. 102, the examiner agrees with how the applicant has interpreted the invention of Seaver (in stating Seaver examiner is referring to Seaver et al- pub 2002/0192360) stating that Seaver discloses: "the samples in Seaver are separate samples run at separate times with the drum rotating at different speeds" or "Seaver describes the different experiments which come from different examples". What the examiner disagrees with is that the "claimed" invention patentably distinguishes itself over Seaver. The examiner has interpreted the claims in the broadest reasonable interpretation. The claims do not explicitly state that the samples are in the same predefined region at the same time, basically so this predefined region holds both samples simultaneously, as it seems the applicant is arguing the claims contain this limitation. The limitation only states that a surface has at least two samples in at least one predefined region; therefore a first sample can be in this region and then physically changed to become a second sample, and thus two samples are in the region, just not simultaneously. Seaver discloses wherein one run (seen in table 1-pg 11 run c-1) the PET web (sample- paragraph 105) has a web speed of 15 m/min and thickness of 1.0 μm at a flow rate of 5.8 cc/min and a separate run (run c-4) having the same web speed and thickness of the PET web and increasing the flow rate to 8.5 cc/min, in the difference between the two runs the flow rate will be increased and the support will have supported at least two samples (the increased flow rate will cause the PET web sample to have a thicker coating) in one predefined region (on the support) and thus read on the claim. Also the predefined region is not specific as to what is being represented, and could be the whole support surface. Therefore Seaver

discloses (as interpreted as broadly as is reasonable in the art) at least one surface with at least two samples each in at least one predefined region thereof (multiple samples- paragraph 106 table I, shows that different speeds are used to create multiple thicknesses of the web samples, both samples will at some point in time each be on the surface of the drum to be tested).

In response to the rejection under 35 U.S.C. 103 according to claims 2, 13-15, 18 and 22, in adding the teaching of Huizanga et al. to Seaver of experimenting with a reference and a test sample, the combination of Seaver in view of Huizanga et al. will include a standard sample (reference) and then a test sample, as this was taught by Huizanga et al. and the combination will bring this teaching into Seaver in view of Huizanga et al. Applicant also states that the combination still lacks "a grounded means with at least one surface and at least two samples on a predefined region of the surface" which has been described above as broadly being taught by Seaver.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the rejection under 35 U.S.C. 103 of claims 10-12 and 28, the motivation for combining Vanmaele et al. with Seaver is in order to scan for useful properties in

Art Unit: 2858

several variants of multilayered materials (Vanmaele et al.- pg 2 line 57-58). In combining these references it would not require extensive research to determine how long to wait between samples, as the samples could be discharged using a common discharging comb. Also it does not seem necessary for the second sample to be charged, discharged, charged again and then tested. In adding the array of samples taught by Vanmaele et al., one of ordinary skill in the art, when testing the array, would charge all the samples of the array with a constant charge, then the array of samples would be tested individually. In the combination of Seavers in view of Vanmaele et al., the samples of the array will all have the same charge as Seaver teaches a constant charge applied to the sample (comparison example 1 pgs 11-12), but the claim of 18 does not patentably distinguish itself over the combination of Seavers in view of Vanmaele et al.

Conclusion

8. Applicant's amendment (the addition of claims 29-32) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

Art Unit: 2858

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Natalini whose telephone number is 571-272-2266. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diane Lee can be reached on 571-272-2399. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeff Natalini



DIANE LEE
SUPERVISORY PATENT EXAMINER